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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,628	10/17/2003	David Scott Jones	47004.000259	8909
21967 7590 12/23/2009 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109				
EXAMINER				
LOFTUS, ANNE				
ART UNIT		PAPER NUMBER		
3691				
MAIL DATE		DELIVERY MODE		
12/23/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/686,628

**Applicant(s)**

JONES, DAVID SCOTT

**Examiner**

ANN LOFTUS

**Art Unit**

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 September 2009.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1.5-10, 12, 14, 15, 19-24, 26, 28, 31-33, 35 and 36 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1.5-10, 12, 14, 15, 19-24, 26, 28, 31-33, 35 and 36 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 6/15/09, 8/28/09  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of the Claims***

1. This action is in response to an amendment filed on 9/1/09. Claims 1, 5-10, 12, 14, 15, 19-24, 26, 28, 31-33, 35 and 36 are pending. Claims 2-4, 11, 13, 16-18, 25, 27, 29, 30 and 34 are cancelled.
2. The application was filed on 10/17/03 without provisional.

### ***Response to Arguments***

3. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. However, certain arguments are addressed as follows.

The applicant argues that the term **proximate to the local post office** would be understood. This is a relative term, and there is no industry standard as to how close the locations must be in order to fall within the scope of proximate. The metes and bounds of the claim would not be clear to a person of ordinary skill in the art at the time of the invention.

The applicant argues that Allen does not teach receiving a mail item comprising a payment product at a mail facility, electronically transmitting payment data associated with the payment product to an intended recipient for processing, and destroying the payment product at the payment processing system. In particular, the applicant says that the example in Allen does not apply because it is a mistake. The examiner respectfully disagrees. The technique is taught as a means to correct a common

mistake, which means the technique was known. Truncating checks is also taught in paragraph 108 page 8. It specifies that in this case, the check is not deposited physically. A person of ordinary skill in the art can learn from non-preferred embodiments, thus a reference is valid for all that it discloses, and not just its own main invention.

The applicant argues that Allen teaches that checks are physically deposited at the bank. Allen also teaches checks that get physically destroyed. The reference must be considered for all that it teaches. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiment. See *In Re Susi*, 169 USPQ 423 (CCPA 1971). A reference must be considered for all that it might suggest to one of ordinary skill in the art, and not just its primary thrust.

The applicant has amended the appropriate clearing path to the optimal clearing path. Clearing path is more broadly interpreted to mean any portion of a path from the origination of a payment instrument. Allen discloses determining a clearing path as cited in the rejection. The case for combining Britto with Allen is moot, since Britto is no longer relied upon.

Applicant's traversal of the Official Notice is not timely. Applicant is arguing over the Official Notice that it is old and well-known to route mail with a zip code. This is no longer relied upon, due to applicant's cancellation of claims. The argument is moot.

***Information Disclosure Statement***

4. The information disclosure statements (IDS) submitted on 6/15/09 and 8/28/09 are being considered by the examiner.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 32 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 32, and 33, the phrase "proximate to the local post office" is a relative term. How close does it have to be to fall within the scope of the claim? The metes and bounds of the claim are unclear, thus the claim is rejected.

The remaining claims listed are rejected as inheriting the problems cited.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 5-8, 10, 12, 15, 19-22, 24, 26, 31-33, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application 2003/0200107 filed

8/8/02 by **Allen** (provisional 3/13/02) in view of US Patent 6,285,777 filed 11/26/97 by **Kanevsky et al.**

As to claims 1, 15, and 31, Allen teaches processing payment products using a computer implemented payment processing system in paragraph 10 page 1. Allen teaches in paragraphs 95-97 page 7 receiving a tangible mail item comprising a payment product. Allen teaches in paragraph 97 page 7 extracting the payment product from the tangible mail item.

Allen teaches in paragraph 15 page 2 electronically transmitting using the computer implemented payment processing system, payment data associated with the payment product to a recipient for processing (the check is read by the check reader and transmitted to the collection processor).

Allen teaches in paragraph 108-110 page 8 processing comprises determining with a computer implemented optimal path module (middle pass processor and packet table processor), an optimal clearing path based at least in part on a type of the payment product.

Allen teaches destroying the payment product at the payment processing system (paragraph 95 page 7, and paragraph 108 page 8 (truncate the payment)).

Allen does not teach wherein the tangible mail item is addressed to an addressed destination in a mail channel, but not sent into the mail channel to the addressed destination. Kanevsky teaches in col 4 lines 30-56 a tangible mail item (paper mail, item 12 Fig1) is addressed to an addressed destination in a mail channel, (Fig 5 shows the postal address information on the envelope) but not sent into the mail channel to the

addressed destination (the sender can opt to have the contents opened and scanned locally, then sent via email to an internet address.) It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Allen to add the tangible mail item is addressed to an addressed destination in a mail channel, but not sent into the mail channel to the addressed destination, because a postal address can be used to identify the recipient since it is generally well-known, but the system then takes advantage of the speed and accuracy of electronic transmission.

As to claims 5 and 19, Allen teaches the payment processing system is located at the mail facility (paragraph 52 page 4 and fig 3, which shows the mail facility receiving and extracting mail collocated with payment processing).

As to claims 6, 7, 20 and 21, Allen teaches the payment data comprises a portion of the payment product that is scanned for electronic transmission (image forwarded to collection processor, paragraph 95 page 7).

As to claims 8 and 22, Allen teaches the coupon scanned in claim 16, and displayed with the payment product in Fig 9 and paragraph 124 page 9. Allen teaches transmission from the reader to the system in paragraph 15 page 2. The coupon and check were transmitted from the payment service center scanner to the collection processor where the images are displayed. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Allen to make explicit a payment product electronically transmitted with items associated with the payment product in order to reduce tracking and shipping paper and also to keep the coupon and check information together for easy reference.

As to claims 10, and 24, Allen teaches a recipient (collection processor) determining a payment type (acceptable vs returns) based on the payment data, and determines an appropriate clearing path, in page 4 paragraph 62. See also paragraph 83 page 6.

As to claims 12 and 26, Allen teaches ACH in paragraph 53 page 4 and truncating checks in paragraph 108 page 8. Truncating checks refers to replacing the physical check with an image replacement document to send via image exchange channels.

As to claims 32, and 33, Allen Fig 3 shows mail items received at a post office. Allen teaches payment processing is proximate to the local post office in paragraph 81 page 6. Allen teaches wherein the payment processing system and the mail facility are local (paragraph 52 page 4 and fig 3, which shows the mail facility receiving and extracting mail collocated with payment processing).

As to claims 35 and 36, Allen does not teach the addressed destination is beyond the mail facility in the mail channel. Kanevsky teaches in col 4 lines 30-60. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Allen to add the addressed destination is beyond the mail facility in the mail channel because the speed advantage of truncation increases with distance. If delivery of paper would take five minutes, then the speed advantage of truncation is small. If delivery of paper would take a week, then the speed advantage of truncation is much greater.



9. Claims 9, 14, 23 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen in view of Kanevsky in view of Official Notice.

As to claims 14 and 28, Allen teaches checks and money orders and other payment instruments in the abstract, and corporate and consumer checks in paragraph 118 page 9. Allen does not explicitly teach cashier checks. Official Notice [now prior art] is taken that these are old and well-known methods of payment. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Allen to add cashier checks in order to be compatible with contemporary payment forms.

As to claims 9 and 23, Allen teaches scanning a payment coupon in claim 16. Allen teaches scanned correspondence pages in Fig 9 and paragraph 124 page 9. Allen teaches electronically transmitting the check as above. Allen refers to information associated with the check, but does not explicitly teach remittance advice, a statement nor accounts receivable data. Official Notice [now prior art] is taken that this is data commonly associated with a payment. It could have been scanned, transmitted and displayed as correspondence. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Allen to explicitly add remittance advice, a statement and accounts receivable data in order to keep associated information with the check data for easy reference.

***Conclusion***

10. While portions of interest have been indicated, all references should be considered for the entirety of their teachings.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANN LOFTUS whose telephone number is (571)272-7342. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kalinowski Alex can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/  
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